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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,910	10/29/2003	Brian H. Silver	07-2116-A	9259
20306 7590 07/21/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER WEAVER, SUE A				
ART UNIT		PAPER NUMBER		
3781				
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07/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/696,910

**Applicant(s)**

SILVER, BRIAN H.

**Examiner**

Sue A. Weaver

**Art Unit**

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-15, 17-20, 22-30, 32, 36-39, 42-56, 58-69 and 71 is/are pending in the application.  
4a) Of the above claim(s) 8, 17, 18, 36, 37, 58, 59 and 61-69 is/are withdrawn from consideration.  
5) ☒ Claim(s) 14, 15, 30, 39, 42-53, 55, 56 and 71 is/are allowed.  
6) ☒ Claim(s) 1, 2, 4-7, 9-13, 19, 20 and 22-29 is/are rejected.  
7) ☒ Claim(s) 32, 38, 54 and 60 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

1. Claims 8, 17, 18,36,37,58,59 and 61-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/20/06 and 6/22/06.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reader et al GB '368, cited by applicant in view of Ishimaru et al JP '076, of record.

Note the nipple of Reader et al having one or more ducts in a solid nipple portion and a mounting structure of various forms. Members h-j are considered to render the nipple radially compressible to prevent passage through the one or more ducts. To have formed the nipple of a soft material with a Shore A hardness of less than about 10 to provide a more natural nursing experience would have been obvious in view of Ishimaru et al.

4. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 10, respectively above, and further in view of Searer '896, of record.

To have provided the nipple with a sealing land, lip and vent in the manner shown in Figure 4 (41,43) and 5 (51) in the manner of Searer would have been obvious. To have used the optional mounting means with a thread and collar for such a bottle as taught by Searer in Figures 1 and 3 would also have been obvious.

5. Claims 19, 20, 22, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reader et al GB '366, cited by applicant in view of Ishimaru et al JP '076 and Searer '896, both of record.

Note the nipple of Reader et al having one or more ducts in a solid nipple portion and a mounting structure of various forms. Member h-j are considered to render the nipple radial compressible to prevent passage of fluid through the one or more ducts. To have formed the nipple of a soft material of a Shore A hardness of less than about 10 to prove a more natural nursing experience would have been obvious in view of Ishimaru et al. To have provided the nipple with a sealing land, lip and vent in the manner of Figure 4 (41,43) and 5 (51) in the manner of Searer would have been obvious. To have used the optional mounting means with a tread and collar for a bottle as taught by Searer in figures 1 and 3 would also have been obvious.

6. Claims 4,5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 2 above, and further in view of White '069, of record.

To have provided the nipple with a plurality of ducts off center to simulate natural nursing would have been obvious in view of White at 67.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 19 above, and further in view of White '069, of record.

To have provided the nipple with a plurality of ducts of center to simulate natural nursing would have been obvious in view of White at 67.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 6 above, and further in view of Morano '608, of record..

To have made the mounting portion of a higher Shore harness A for secure mounting would have been obvious in view of such teaching by Morano.

9. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 10 above, and further in view of Parkin '236, of record.

To have formed the vent in the manner of Parkin for secure function would have been obvious.

10. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 27 above, and further in view of Dunn '766, of record.

11. To have provided a plurality of nipples with indicia including color coding would have been obvious in view of such teaching by Dunn.

12. Claims 32,38, 54 and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 14,15, 30, 39, 42-53, 55, 56 and 71 are allowed while claims 3,16,21,31,33-35,40,41,57,70 and 72 have been canceled.

14. Applicant's arguments filed 3/26/09 have been fully considered but they are not persuasive. Contrary to applicant's remarks the examiner finds no indication that the nipple of Reading is of a "hard rubber". To have made the of a soft rubber of a Shore hardness of 10 for a more natural nursing experience would have been obvious in view

of Ishimaru et al teaching such nipple. As requested, the paragraphs have been grouped to make the rejections clearer to the applicant.

15. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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(Date)

Typed or printed name of person signing this certificate:

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### **Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_.  
(Date)

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Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Weaver whose telephone number is (571) 272-4548. The examiner can normally be reached on Tuesday-Friday (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor is Anthony Stashick\_. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sue A. Weaver/  
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